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Datasheet for the decision of 13 March 2009

Case Number: R 0010/08

Appeal Number: T 0534/04 - 3.3.05

Application Number: 97122407.6

Publication Number: 0850895

IPC: C04B 24/26

Language of the proceedings: EN

Title of invention:
Cement dispersant, method for producing polycarboxylic acid for cement dispersant and cement composition

Petitioner/Patentee
Nippon Shokubai Co., Ltd.

Other party/Opponent
BASF SE

Headword:
Fundamental violation of Article 113 EPC and procedural defect under Rule 104(b) EPC/NIPPON SHOKUBAI Co., Ltd.

Relevant legal provisions:
EPC Art. 112a, 113(1), 113(2), 123(2)
EPC R. 104(b), 106;
RPBA R. 15(5)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Petition for review"
"Not clearly inadmissible"
"Clearly unallowable"

Decisions cited:
G 0012/91, G 0007/93

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Große Beschwerdekammer | Enlarged Board of Appeal | Grande Chambre de recours

Case Number: R 0010/08

D E C I S I O N
of the Enlarged Board of Appeal of 13 March 2009

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Decision under review:
Decision of the Technical Board of Appeal 3.3.05 of the European Patent Office of 22 July 2008.

Composition of the Board:

Chairman: P. Messerli
Members: B. Schachenmann
T. Kriner

Summary of Facts and Submissions

I. The petition for review concerns decision T 534/04 of the Board of Appeal 3.3.05 revoking European patent No. 0 850 895.

II. The proceedings in case T 534/04 can be summarized as follows:

(a) The opposition division maintained European Patent No. 0 850 895 in amended form. Against this decision both the proprietor (appellant I) and the opponent (appellant II) filed an appeal. Together with the statement setting out the grounds of appeal the proprietor filed a set of new claims 1 to 3 as sole request. In its reply to the proprietor's statement of the grounds the opponent raised an objection under Article 123(2) EPC against claim 1 of this request. The proprietor then filed three auxiliary requests in addition to the main request.

(b) After the written phase of the appeal proceedings the Board of Appeal 3.3.05 summoned the parties to oral proceedings scheduled to take place on 22 July 2008. The Board did not send the parties a communication under Article 15(1) RPBA in view of these oral proceedings.

(c) At the oral proceedings, after the chairman of the Board had summarised the relevant facts as appearing from the file, the requirements of Article 123(2) EPC with regard to the proprietor's main and three auxiliary requests on file were

discussed with the parties (cf. the Board's minutes of the oral proceedings of 22 July 2008, in the following referred to as 'the minutes'). After this discussion the chairman declared the debate closed without having stated the final requests of the parties beforehand. After deliberation of the Board the chairman immediately announced the decision according to which the decision under appeal was set aside and the patent was revoked.

(d) What happened then is recorded in the minutes as follows: "When the chairman announced that the oral proceedings were closed, appellant I requested to be given an opportunity to file a further auxiliary request. The legal member pointed out that the decision was already announced and that it could not be nullified by the Board. The Chairman then closed the oral proceedings".

(e) The written decision T 534/04 revoking the patent was notified to the parties by registered letter posted on 9 September 2008. The ground for the revocation was that neither claims 1 and 2 of the proprietor's main request nor claims 1 and 3 of the first and second auxiliary request nor claim 1 of the third auxiliary request were in conformity with Article 123(2) EPC.

III. On 7 November 2008 the proprietor (in the following referred to as the petitioner) filed a petition for review of this decision by the Enlarged Board of Appeal pursuant to Article 112a EPC. The petition is based on

the grounds referred to in Article 112a(2)(c) EPC, that a fundamental violation of Article 113 EPC occurred and, alternatively, Article 112a(2)(d) in combination with Rule 104(b) EPC, that the Board of Appeal decided on the Appeal without deciding on a request relevant to the decision.

IV. The submissions of the petitioner can be summarized as follows:

(a) The petitioner's right to be heard was fundamentally violated since its representative was taken by surprise by the immediate announcement of the decision of the Board of Appeal after deliberation without having any chance to file a further request. The omission by the chairman to state the final requests of the parties before declaring the debate closed not only infringed Article 15(5) of the Rules of Procedure of the Boards of Appeal (RPBA) but had prevented the petitioner from overcoming, by filing a new request, an objection under Article 123(2) EPC raised by the opponent for the first time in the oral proceedings. The parties to the proceedings could expect the Boards of Appeal to follow the binding regulations of the RPBA as e.g. Article 15(5) RPBA. Thus, the petitioner's representative could rely on the firm expectation that the debate could not be closed prior to the Chairman stating the final requests of the parties. This was not a mere formality as the case had changed during the oral proceedings because of the new objection under Article 123(2) EPC raised by the opponent.

(b) As to the unsuccessful attempt of the petitioner to file a further auxiliary request after deliberation of the Board, its representative submitted that this attempt was not made after the announcement of the decision but, contrary to the minutes, during the announcement. Since at the moment of his intervention the announcement of the decision was not concluded yet, his request was made while the proceedings were still pending. The debate could and should therefore have been re-opened which would have given him the opportunity to file a new request in response to the new objection raised by the opponent.

V. Oral proceedings before the Enlarged Board of Appeal in its composition pursuant to Rule 109(2)(a) EPC took place on 13 March 2009.

VI. The petitioner requested that the decision to revoke European Patent No. 0 850 895 be set aside and that the opposition proceedings before the Board of Appeal 3.3.05 be re-opened.

Reasons for the Decision

Admissibility of the petition for review

1. The petitioner is adversely affected by the decision T 534/04 to revoke its patent. The petition for review was filed on the grounds referred to in Article 112a(2)(c) EPC and, alternatively, Article 112a(2)(d) in combination with Rule 104(b) EPC.

It contains an indication of the decision to be reviewed and reasons for setting aside this decision. The petition therefore complies with the provisions of Article 112a(1) and (2) EPC and of Rule 107(1)(b) and (2) EPC.

2. The written decision T 534/04 was notified to the parties by registered letter posted on 9 September 2008. The two month period for filing a petition for review expired on 19 November 2008. The present petition for review was filed and the fee was paid on 7 November 2008. The petition therefore also complies with Article 112a(4) EPC.

3. Pursuant to Rule 106 EPC a petition under Article 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings. According to the minutes (cf. point II (d), *supra*) the petitioner had "requested to be given an opportunity to file a further auxiliary request when the chairman announced that the oral proceedings were closed", i.e. after the decision had been announced. Therefore, the legal member of the Board had "pointed out that the decision was already announced and that it could not be nullified by the Board". However, in the oral proceedings before the Enlarged Board of Appeal the petitioner's representative submitted that the minutes were not correct in that he had actually intervened during the announcement of the decision (cf. point IV(b), *supra*). In this respect, the Enlarged Board of Appeal notes that the petitioner had neither

requested a correction of the minutes under Rule 139 EPC nor raised this point in the reasons for the petition. However, this factual question can be left open since what is relevant here is that, as a reaction to the petitioner's intervention, the Board of Appeal 3.3.05 declared itself formally bound by the announced final decision so that it "could not be nullified by the Board".

The requirement of Rule 106 EPC, first alternative, according to which an objection is only admissible if it "was raised during the appeal proceedings and dismissed by the Board" implies that the Board would still have had the possibility to rectify the procedural defect when the objection was raised. This follows from the *travaux préparatoires* according to which the main purpose of introducing the obligation to raise objections under Rule 106 EPC is to provide the Boards of Appeal with a means for rectification of a possible procedural defect actually during the appeal proceedings (cf. CA/PL PV 19, point 64). Obviously, this purpose can no longer be fulfilled if a Board declares itself formally bound by its final decision at the time a procedural objection should be raised. In such an exceptional case, as in the present one, the petitioner should be given the benefit of the second alternative of Rule 106 EPC, as his objection in respect of the alleged procedural defect could not have been raised "during the appeal proceedings" within the meaning of Rule 106 EPC.

4. Accordingly, the Enlarged Board of Appeal is satisfied that the petition is not clearly inadmissible.

Allowability of the petition for review

5. In support of the alleged fundamental violation of Article 113 EPC the petitioner's representative referred to the fact that the chairman had not stated the final requests of the parties before declaring the debate closed thereby infringing Article 15(5) of the Rules of Procedure of the Boards of Appeal (RPBA). This had prevented him from filing a further request as he was of the firm belief that the debate could not be closed prior to the Chairman stating the final requests of the parties. The Enlarged Board of Appeal agrees with the petitioner that Article 15(5) RPBA is binding upon the Boards of Appeal (see Article 23 RPBA) and that, in order to avoid any doubt about the parties' requests, the chairmen of the Boards of Appeal should state the final requests of the parties before closing the debate for deliberation. However, within the framework of the proceedings under Article 112a EPC, an infringement of Rule 15(5) RPBA can only become relevant as far as it involves a fundamental violation of Article 113 EPC or a fundamental procedural defect under Article 112a(2)(d) in combination with Rule 104(b) EPC.

6. Concerning Article 113(1) EPC it is to be examined whether the petitioner had sufficient opportunity to comment on the grounds and evidence on which the decision of the Board of Appeal 3.3.05 is based. In this connection it is noted that the requests discussed at the oral proceedings were those filed by the petitioner in the preceding written proceedings. The petitioner's representative did not deny that he could comment on all the objections raised by the opponent

under Article 123(2) EPC against these requests before the debate was closed. Even if some of the objections may have been raised for the first time at the oral proceedings, the petitioner neither asked for an interruption of the proceedings to consider the new objections nor reacted by amending the requests during the debate. Moreover, it is uncontested that the reasons for the decision of the Board of Appeal 3.3.05 are based on the debate and refer to the debated requests. In these circumstances, even if the chairman deviated from the procedure provided for in Article 15(5) RPBA by not stating the requests before closing the debate, this omission did not affect the petitioner's right to be heard under Article 113(1) EPC in that he had sufficient opportunity to present his comments on the grounds and evidence on which the decision of the Board of Appeal 3.3.05 is based.

7. As far as a possible fundamental violation of Article 113(2) EPC is concerned, reference is made to the decision G 7/93 (OJ EPO 1994, 775, point 2.1) of the Enlarged Board of Appeal according to which "this provision of the EPC does not give any right to an applicant in the sense that the EPO is in any way bound to consider a request for amendment put forward by the applicant. The effect of this provision is merely to forbid the EPO from considering and deciding upon any text of an application **other than that** 'submitted to it, or agreed, by the applicant or proprietor ...'" (emphasis as in the published version). There is no indication in the file nor did the petitioner's representative submit that, before the debate was closed, he had in any way indicated a wish to amend the requests on file or to file a further request in

response to the preceding discussion. There can be no doubt that the only requests on file when the chairman closed the debate for deliberation where those filed in the written procedure. The Board of Appeal 3.3.05 did not, therefore, decide upon any text other than that submitted to it by the proprietor.

8. Regarding the alleged fundamental procedural defect under Article 112a(2)(d) in combination with Rule 104(b) EPC it has to be considered whether the Board of Appeal 3.3.05 "decided on the appeal without deciding on a request relevant to that decision". In this connection the representative of the petitioner argued that he could rely on the firm expectation that the debate could not be closed before the final requests of the parties had been stated by the chairman according to Article 15(5) RPBA. He therefore was surprised that the chairman immediately announced the final decision after deliberation which prevented him from filing a further request relevant to that decision. However, notwithstanding the fact that the chairman failed to state the pending requests again, he had declared the debate closed as a matter of fact. As set out by the Enlarged Board of Appeal in decision G 12/91 (OJ EPO 1994, 285, point 3) the moment a decision is pronounced is not the last moment at which parties may still make submissions: "This must be done at an earlier point in the proceedings to allow the decision-making department time to deliberate and then to issue its decision based on the parties submissions. As far as oral proceedings are concerned, established Board of Appeal case law has this moment as the closing of the debate (...)". Thus, even if the debate could be re-opened in exceptional cases, the parties have to expect

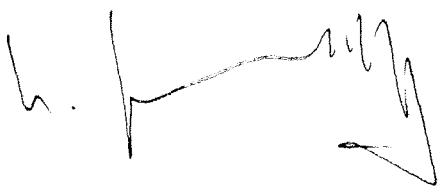
that, as long as it is not re-opened, a decision can be given after deliberation. In view of this established practice, the petitioner's representative could not be surprised by the announcement of the decision after the debate had been closed, notwithstanding the fact that the chairman had omitted to state the (unquestionably clear) requests beforehand. The last point in time for him to intervene would have been the moment at which the chairman declared the debate closed for deliberation. He then should have requested that the debate be re-opened if he intended to file a further request. Thus, whether the petitioner intervened during or after the announcement of the decision is not relevant for the present case. The Enlarged Board of Appeal therefore is satisfied that the Board of Appeal 3.3.05 decided on the relevant requests of the petitioner, i.e. on the requests on file when the debate was closed for deliberation.

Order

For these reasons it is decided unanimously that:

The petition is rejected as clearly unallowable.

The Registrar: The Chairman:



W. Roepstorff P. Messerli